

UNITED STATES DEPARTMENT OF COMMERCE

Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

| | | | |
|-----------------|-------------|----------------------|---------------------|
| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|

© 2000 Blackwell Science Ltd, *Journal of Internal Medicine* 247: 391–397

7. 1002-2-02

ROBERT P. RAYMOND
BOEHMINGER INSELNETH CORPORATION
900 RIDGEWAY ROAD
P.O. BOX 368
NORFIELD CT 06877

PMID: 1069787

EXAMINER

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1656

DATE MAILED:

02/04/2011

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

| | | | |
|--------------------------------------|--------------------------------------|---|--|
| Application No. 09/368,670 | Applicant(s) Llinas-Brunet | | |
| Examiner David Lukton | Group Art Unit 1653 |  | |

This action is **FINAL**.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

X Claim(s) 1-99 is/are pending in the application.

Of the above, claim(s) 67-72, 75, 78, 81, 83, 84, 89-95, and 97-99 is/are withdrawn from consideration.

X Claim(s) 73, 74, 76, 77, 79, 80, 82, and 85-88 is/are allowed.

X Claim(s) 1, 6-12, 16, 20, 21, and 40 is/are rejected.

X Claim(s) 2-5, 13-15, 17-19, 22-39, 41-66, and 96 is/are objected to.

Claims _____ are subject to restriction or election requirement.

The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number)

received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received:

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e)

X Notice of References Cited, PTO-892
 Information Disclosure Statement(s), PTO-1449 Paper No(s) _____
 Interview Summary, PTO-413
 Notice of Draftsperson's Patent Drawing Review, PTO-948
 Notice of Informal Patent Application, PTO-152

U. S. Patent and Trademark Office
PTO-326 (Rev. 9-95)

Pursuant to preliminary amendment, claims 87 and 88 have been amended to change their claim dependence.

Applicants' election of Group 2 with traverse is acknowledged, as is the elected specie (compound # 633, table 6, page 141). Applicants have traversed by arguing that Groups 2, 6, 10 and 14 should be rejoined with Group 2. The examiner agrees, but only in the event that the claims of Group 2 are determined to be novel. As for the issue of rejoining one or more of the other non-elected groups, the fact is that Group 2 encompasses numerous peptides that have been previously disclosed. Accordingly, the restriction is justified. However, in the event that significant limitations are introduced into group 2 (e.g., that R_1 and R_{1a} must form a ring, and that A cannot be just anything that is bonded to a nitrogen atom), it would be appropriate to consider the possibility of rejoining one or more of the non-elected groups.

Applicants have also requested the rejoining of claims 79, 80 and 85-88. These claims will be joined with the elected group. Claims 1-66, 73, 74, 76, 77, 79, 80, 82, 85-88, 96 are examined in this Office action; claims 67-72, 75, 78, 81, 83, 84, 89-94 and 97-99 are ⁴⁵ withdrawn from consideration.

✱

Claim 1 is rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention.

In claim 1, part (b), substituent "B" is described as being C₃₋₇ cycloalkyl or C₄₋₁₀ alkylcycloalkyl, optionally substituted with carboxyl. This is then followed by two possible structures as examples. However, this is improper form. Claim 1 should state just that B is C₃₋₇ cycloalkyl or C₄₋₁₀ alkylcycloalkyl, optionally substituted with carboxyl; a dependent claim can be added which provides the two (subgeneric) examples.

✱

The following is a quotation of the appropriate paragraphs of 35 U.S.C §102 that form the basis for the rejections under this section made in this action.

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2) and (4) of section 371(c) of this title before the invention thereof by the applicant for the patent.

Claims 1, 6-12, 16, 20, 40 are rejected under 35 U.S.C. §102(e) as being anticipated by Naumann (USP 5,962,638).

Naumann teaches (col 17) sequence ID No. 3, which is the following peptide:

Ala-Ala-Ala-Ala-Ala-OMe

This peptide is encompassed by instant claim 1 if the substituent variables correspond as follows:

a = b = 0;
B = Hydrogen;
R1 = R2 = R3 = R4 = alkyl;

A = N-substituted amino.

Thus, the claim is anticipated.

✱

Claims 1, 6-12, 16, 20, 21, 40 are rejected under 35 U.S.C. §102(e) as being anticipated by Eichner (USP 5,994,311).

Eichner teaches (col 5, line 35) the following peptide (single letter abbreviations):

L-A-E-L-L-D-G-E-G

This peptide is encompassed by instant claim 1 if the substituent variables correspond as follows:

a = b = 0;
B = Hydrogen;
R1 = R3 = R4 = alkyl;
R² = alkyl substituted with carboxyl
A = N-substituted amino.

Thus, the claims are anticipated.

✱

Serial No. 368,670
Art Unit 1653

-5-

It is suggested that applicants amend claims 93-95 as appropriate.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton. Phone: (703) 308-3213.

An inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



DAVID LUKTON
PATENT EXAMINER
GROUP 1800